

REMARKS

This Amendment is submitted simultaneously with filing of the above identified application.

With the present Amendment applicants have cancelled the original claims and submitted a new set of claims 11-23, with claim 11 the broadest claim currently on file, and the other claims depending on claim 11 directly or indirectly.

It is respectfully submitted that the new features of the present invention are not disclosed in the references applied by the Examiner in the parent case.

Claim 1 specifically defines that the purpose of the safety element is not to reach a dampening of vibrations, but instead the safety element is designed and arranged so that it does not counteract the dampening of the vibrations by the elastic element.

The patent to Minamitate applied by the Examiner discloses a vibration damping handle for a hand-operated electro-mechanical or

pneumatic tool, etc. In the Examiner's opinion this reference discloses an additional safety element fixed at a mounting side, through which a mounting side of a gripping part is connected with a mounting part, and the safety element is movable to avoid transmission of vibrations, through the safety element during predeterminatable operation. In this reference the safety element provides dampening of the vibrations, which however has nothing to do with the applicant's invention. In contrast, in the hand power tool of the present invention, the safety element is movable to avoid the passage of vibrations through the safety element and its objective is not to counteract the dampening of the vibrations by the elastic element.

It is therefore believed to be clear that the new features of the present invention which are now defined in claim 11 are not disclosed in the patent to Minamidate. The patents to Jares and Weber also do not teach the above mentioned new features of the present invention as now defined in claim 11. None of the references discloses any hint or suggestion for such features.

It is believed to be clear, that in order to arrive at the applicant's invention from the references taken singly or in combination with one another, the references have to be fundamentally modified by including

into them the features which were first proposed by the applicants. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the references do not provide any hint or suggestion for such modifications.

The new features of the present invention are first proposed by the applicant's, and there is no justification to say that these new features could be derived from the references, without exercising a hindsight. However, as stated in *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-13 (Fed. Cir. 1983):

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim of the insidious

effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is believed that the present invention as defined now in claim 11 is not disclosed in the references, the references do not have any suggestions for the new features of the present invention as defined in claim 11, and these features can not be derived from the references as a matter of obviousness.

Claim 11 should be considered as patentably distinguishing over the art and should be allowed.

The Examiner's attention is also respectfully directed to the features of some dependent claims.

Claim 20 defines that the safety element is connected to the gripping part exclusively via the elastic vibration damping element as shown in Figures 3 and 4. Claim 21 defines that the safety element is formed by a rigid rod which is completely surrounded by the elastic vibration damping element as described for example on lines 7-9 on page 10. Claim 22 defines that the prevention of the vibration transmission is reached by the corresponding distance between the elements, which is filled with the elastic material. Claim 23 defines that the discs 30,32 are non-releasably held in

the corresponding chambers, as explained on page 10, in lines 18-20.

It is respectfully submitted that the new features of the present invention as defined in claims 20, 21, 22 and 23 are not disclosed in any of the references and can not be derived from them as a matter of obviousness. Therefore, these claims should be considered as patentably distinguishing over the art not only because they depend on the presumably allowable claim 11, but also because they contain a patentable subject matter per se.

As for the other claims, these claims depend on claim 11, they share its presumably allowable features, and therefore it is believed that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be

carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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OCT 10 2003

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